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HAROLD B. WILLEY, Cl

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954.

No. 748

MALL TOOL COMPANY,
Petitioner,

vs.

BORG-WARNER CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI.

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Chicago, May 11, 1955.

THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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OPINIONS BELOW.

Subsequent to the filing of the Petition herein, the latest opinion of the Court of Appeals for the Seventh Circuit in this case has been reported at 105 U. S. P. Q. 147.

STATEMENT OF THE CASE.

The Petition for Writ of Certiorari presents no grounds specified by Rule 19 for issuance of the writ. The questions sought to be presented are not in this case but have been contrived by Petitioner to lend a semblance of substance to the Petition.

This is an ordinary patent case, exceptional only in that the patent presents a revolutionary improvement in an old mechanical art. Petitioner's attempted distinction of

the infringing devices from the patent disclosure and claims is based only upon verbal and technical contentions that completely ignore the substance of the structures and patents involved.

The Court of Appeals Has Expressly Considered and Rejected All of Petitioner's Contentions.

The patent in suit is on a chain saw (R. 344-353). In his preferred embodiment, the patentee showed the saw chain having as its principal cutting elements a pair of opposed L-shaped teeth (router teeth) each suspended by its vertical shank and having a sharpened horizontal toe projecting from the side of the chain toward its middle. This horizontal toe sliced the chip from the bottom of the kerf, where it lay to be removed by a non-cutting depth gauge which was longitudinally spaced from the router tooth (Figs. 12, 15, R. 348). In his preferred embodiment the patentee showed the saw chain also carrying separate vertical side-cutter teeth to make the vertical cut at the side of the kerf (Fig. 14, R. 348). The infringing chain, here in issue, typified by Defendant's Exhibtis 1 and 4 (R. 303, 306) is distinguished merely in that it omits the separate side cutters (which had been used on some of the chains made by Petitioner) and shifts the work of these separate side-cutter teeth to the sharpened vertical shanks of the router teeth.

The commercial impact of the patented chain was well expressed by the District Court in its Findings 13-15 (R. 332), in which the Court reviewed the evidence of sales of the patented chains. The Court found that Petitioner's sales of prior-art non-infringing chains fell from 67% of its chain volume in 1950 to 30% in two years; in the same period its sales of infringing saw chains rose from 33% to 70%, and its sales of complete chain saws equipped with

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infringing chains to 93% of such sales (Finding 19; 333).

As the District Court found, the saw chain art went ck to 1885, but prior to the patentee Hassler no one had r employed a saw chain with teeth of the type to which patent in suit is directed (Finding 12; R. 331).

The District Court found the broad claims (9, 10, 13, 14) of the patent in suit invalid. After expressing ne uncertainty over the issue (R. 325-326), it construed ims 1 and 2—the only claims before this Court—as dis-sing invention and valid, only when limited to require separate side cutters as shown in the patentee's pre-red embodiment (R. 334). The District Court also found ims 1 and 2 infringed by saw chains made by Petitioner ich employed separate side-cutter teeth (Def. Ex. 5 and R. 307, 308), but refused to apply the doctrine of equiva-ts to structures in which the work of the side cutters s shifted to the sharpened vertical shanks of the router th (Def. Ex. 1 to 4, R. 303-306).

The Court of Appeals, accepting and endorsing the Find-gs of Fact, reversed this last ruling of the District Court. e Court of Appeals held that such a construction of this oneer patent violated the law as laid down by this Court *Graver* v. *Linde*, 339 U. S. 605, 607-609. It applied the strict Court's findings that the accused devices did ex-ly the same work as the patented chain saw in substan-lly the same manner, and were therefore the equivalents the patented structure. In this reasoning the Court of peals meticulously applied the law of the *Graver* case.

The Petition asks essentially for a review of the facts. is Court has repeatedly stated that routine review of facts is not the office of certiorari. *Keller* v. *Adams-mpbell & Company, Inc.* (1924), 264 U. S. 314, 319. While Petition speaks of imagined conflicts of decision and

alleged misapplication of the patent law, and prays for an opportunity to embellish the doctrines of equivalency and file wrapper estoppel with ingenious novelties, the record does not present the alleged issues which are advanced as invoking this review.

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ARGUMENT.

The "Questions Presented" By Petitioner Are Not in This Case.

The Petition in this cause sets forth four questions, the first having four subsidiary questions. It will be shown in this brief that none of these questions as framed by Petitioner is presented by this record; they are created merely by adroit use of a fragmentary appendix produced by interlineations and a cunning excision of relevant facts.

Petitioner's first question with four subordinate questions (Pet., p. 2), in effect attacks the Court of Appeals' holding that the Shipe patent (R. 384) does not anticipate Claims 1 and 2 of the patent in suit, and insinuates, contrary to Petitioner's own admissions, that the Court of Appeals ignored the patent claims in finding the infringing structures equivalent to the structure of those claims.

Question 1A. The Shipe patent of 1885 is practically the only patent which Petitioner relies on in this Petition. It formed the substance of Petitioner's case in the Court of Appeals, although Petitioner had relied on 27 patents on the trial.

The Shipe patent had been brought to the attention of the Patent Office by the patentee (Def. Ex. 9, p. 44). The Patent Office granted Claims 1 and 2 over that patent.

Considerable testimony was evoked in the District Court on the Shipe patent and the District Court held Claims 1 and 2 valid thereover. Petitioner's expert readily admitted the many structural and functional distinctions which existed between the Shipe disclosure and the saw chain covered by the Hassler patent (R. 242-6, 251, 266, 278). The most significant of the testimony is that of Petitioner's

expert that if the Shipe tooth were to be used on a modern chain saw it would unquestionably have to be redesigned (R. 244).

The Court of Appeals reviewed the disclosure of the Shipe patent at length (Pet. App., pp. 8-9), and while Petitioner says (Pet., p. 9),

> "There is no evidence that the Court itself made any examination of Claims 1 and 2 to see if they actually defined anything different from Shipe's chain saw."

and (Pet., p. 15),

> "No finding was made that Claims 1 and 2 are distinguished in any way from Shipe's device."

the Petition also quotes from the Court of Appeals' opinion that (Pet., p. 9),

> " 'Despite any terminology employed by Hassler in presenting his case, an *examination of his claims* and specification indicate a sharp divergence from anything that Shipe taught.' " (Emphasis supplied.)

The Court of Appeals' opinion (Pet. App., p. 2) quotes Claim 1 in full and states, as Petitioner does (Pet., p.7) that Claims 1 and 2 are for all essential purposes the same.

The most cursory examination of the Shipe structure discloses that it does not respond to Hassler's claims 1 and 2. This is wholly apart from the complete lack of correspondence in the structure and function of the Shipe and Hassler devices which this Court, in *Graver* v. *Linde*, 339 U. S. 605, 608-609, ruled would control over any mere verbal correspondence.

Both of the Hassler claims demand, among other things, that the slicing elements of the router teeth extend "from one marginal edge of said chain saw towards the longi-

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tundinal center-line" thereof, and that these slicing elements be "arranged in pairs oppositely disposed and spaced laterally apart".

Shipe has no such slicing elements. The Shipe teeth are suspended from a shank in the middle of the tooth and extend across the full width of the kerf. They are not arranged in pairs, are not oppositely disposed, and are not spaced laterally apart (R. 384).

In fact, the Shipe patent makes a virtue of the fact that the chain is composed of a series of identical teeth and says:

> "* * * each link of the chain is made to displace the whole chip, instead of depending upon succeeding links to do so, and to effect the ready clearance of the cut chips; * * * said bit or cutter of each link removing the chip the full width of the kerf, and thus doing away with the necessity of a series of cutters applied to each succeeding pair of links, as in a former invention of mine." (R. 385, Col. 1, lines 18-28).

There is no need here to review all of the structural and functional differences of the Shipe chain. It was designed to be drawn around a log and not to operate on a cutter bar of a chain saw. It forces the chips upwardly *through the chain*, as distinguished from the Hassler chain in which the chips are sliced from the bottom of the kerf and left there to be scavenged by a following non-cutting depth gauge. The Court of Appeals fully treated these significant and determinative considerations (Pet. App., pp. 8-9).

Questions 1B and 1C. The foregoing simple statement of what happened to Shipe in the Court of Appeals destroys any contention based upon Petitioner's asserted Questions 1B and 1C.

There is nothing in the Shipe patent that approaches Hassler or qualifies the range of equivalency accorded claims 1 and 2.

Question 1D. The question purportedly raised as Question 1D (Pet., p. 2) would have this Court review the Findings of Fact by the District Court, affirmed by the Court of Appeals, that the saw chain claimed in Hassler's claims 1 and 2 involves invention. Petitioner assails this conclusion on the ground that the combination was non-inventive. The Court of Appeals flatly ruled on this question (Pet. App. 7). The District Court pointed out that although the art of saw chains runs back to 1885, and the record contained at least sixteen patents on saw chains (R. 384, 392, 402, 412, 420, 424, 428, 432, 438, 442, 450, 458, 466, 482, 496, 517) in the intervening period, to the time of Hassler's invention no one had contrived the Hassler combination.

This Court will "not disturb the concurrent findings upon the issues presented * * * in the petition for certiorari." *Faulkner* v. *Gibbs,* 338 U. S. 267, 268.

Were the question of invention open on this record, the long history of saw chains all employing merely conventional saw tooth forms culminating in the revolutionary chain made by Hassler with its markedly impressive impact on the commercial art, would lead inevitably to the same conclusion that the Patent Office, the District Court, and the Court of Appeals reached.

Petitioner's Second "Question Presented" Attempts to Create a Question of File Wrapper Estoppel Where None Exists.

Petitioner states as its second "question presented" (Pet., p. 3):

> "2. Does a deliberate course of conduct by a patent applicant, short of restricting claims by amendment, which shows a definite intention to accept a monopoly with a specific limitation, estop the applicant from

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> ignoring this same limitation in asserting that a device infringes because it is a mechanical equivalent of the patented device?''

This Court has in a series of decisions unaltered in doctrine for seventy-five years, applied the principle of file wrapper estoppel. The doctrine has been most succinctly stated by the late Chief Justice Stone in *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 137. This doctrine dictates that a patentee who amends his patent claim to avoid a rejection by the Patent Office may not thereafter ask the courts to construe that claim with the same scope that it would have possessed had the amendment not been made; in other words, compliance with the ruling of the Patent Office to secure the patent operates as a disclaimer of the subject matter originally claimed, which may not thereafter be recaptured.

This is a wholesome doctrine, but it has no application in this case. The Court of Appeals expressly stated that

> ''* * * The trial court did not find any of the elements of estoppel in the evidence presented and we think, likewise, that the record does not sustain defendant's contention in this respect.'' (Pet. App. p. 9.)

Petitioner has, in its Appendix, set forth under the title ''Abstract of Hassler Patent File Wrapper'' (Pet. App., pp. 59-60) an adroitly emasculated version of the file wrapper and contents of the Hassler patent (Def. Ex. 9).

Where the actual exhibit contains two typewritten pages of a discussion of the distinctions between Shipe and Hassler, Petitioner quotes merely eight lines devoted to a single structural distinction. Petitioner ignores the remainder of the text which points out several other distinctions which conclusively differentiate Shipe and Hassler (Def. Ex. 9, pp. 44-46).

It is upon this single statement, presenting a completely

distorted picture of what occurred in the prosecution of the Hassler patent, that Petitioner would ask this Court to undertake a review of the doctrine of file wrapper estoppel.

At this period in the prosecution of the Hassler patent application Claims 1 and 2 were before the Patent Office, substantially as finally issued (later modified merely for clarity and not in substance; Def. Ex. 9, p. 36). The Shipe patent had never been cited against these claims, the claims had never been rejected as lacking invention, and the Patent Office never required or suggested any change of substance in these claims.

The Court of Appeals ruled directly on this issue (Pet. Ex. 9) and nothing is presented here that would challenge the conclusions of the Court of Appeals except by ignoring what actually occurred in the Patent Office.

The cases cited by Petitioner to create an asserted difference in the application of the doctrines of file wrapper estoppel by the Courts of Appeals of different circuits do not present any such situation.

In *Bassick Co.* v. *Faultless Caster Corp.*, 105 F. 2d 229, 231, the Seventh Circuit Court of Appeals merely held that it would not consider the patentee's argument to the Patent Office for the purpose of changing the plain wording of the patent claim, where the patentee argued that limitations in the claim be ignored to make the claim correspond to certain representations made in the argument to the Patent Office. The Court of Appeals said it had considered the argument made to the Patent Office to help determine the novelty disclosed in the patent, and to construe the claims in suit, but that when the novel feature was identified it was clear that the patent claims did not include this feature. This is the same treatment accorded Claims 9, 10, 13, and 14 of the Hassler patent by the Court of Appeals in this case.

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In *Spaulding & Bros.* v. *Wanamaker,* 256 Fed. 530, next cited by Petitioner, the Second Circuit dealt with the classical file wrapper estoppel situation. The patentee had sought broad claims in the Patent Office and after repeated rejection had narrowed these. Subsequently, in litigation to enforce the patent, the patentee sought to recapture by a construction of the patent claim, the scope which had been forfeited by the amendments made in the Patent Office to induce the issuance of the patent. Learned Hand, then District Judge said, merely in passing, that:

> "In the consideration of a file wrapper we do not look at the arguments of the applicant to the Examiner."

The statement was merely *obiter dictum.* Even had it been a specific ruling in the case, it would not conflict with anything done by the Seventh Circuit Court of Appeals in this case.

In *Modern Products Supply Co.* v. *Drachenberg,* 152 F. 2d 203, 207, the Sixth Circuit Court of Appeals did not employ statements made by the applicant to the Patent Office to modify the claims or in effect to permit such argument to constitute a file wrapper estoppel, but merely used those statements as significant evidence in determining whether or not there was structural identity in the substantial features of the accused machine and that covered by the patent claims. The Court gave to these arguments merely evidentiary weight in determining whether or not the differences between the accused and patented devices related to matters of substance or were merely formal differences.

There is no comparable problem in this case, where the Petitioner seeks to restrict the reading of the patent claim by reference to the patentee's discussion of prior art in the Patent Office, and the Court has independently found that that prior art has no functional or structural correspondence to the patented device.

In *Cabot, Inc.* v. *Huber Corp.*, 127 F. 2d 805, the Fifth Circuit Court of Appeals held that where the specification disclosed equipment and procedures which required turbulent agitation of the carbon being pelletized, the term "turbulent agitation", prominent in each claim, could not be satisfied by a procedure in which there was mere gentle pouring and shifting of the ingredients to form pellets. The Court referred not only to what was stated in the specification, but particularly to the fact that when the patent was before the Patent Office and the claims rejected upon a broad meaning of the term "turbulent agitation", the patentee induced the Board of Patent Appeals to reverse the action of the Examiner and rule that the patentee was entitled to a patent on a process involving "turbulent agitation". On the same basis the Commissioner of Patents, in an interference, ruled that the limitation to "turbulent agitation" distinguished from the method of the interfering patent and dissolved the patent interference. This is classical file wrapper estoppel, based not on what a patent applicant may have said in argument, but on action by the applicant which induced the Patent Office to alter its ruling, where the previous ruling was based on a misconstruction of the patent claim terms. No situation even approaching this is involved in the present case.

In *Allen Bradley Co.* v. *Erie Resistor Corp.*, 104 F. 2d 150, the Third Circuit Court of Appeals had before it a patent that contained claims to a procedure incorporating the step of calcining carbon black "at substantially graphitizing temperatures." The specification contained no specific data as to what graphitizing temperatures were, and the Court relied on both the independent evidence of witnesses that graphitizing temperature at the time the application was filed meant a temperature of about 2200°C. and the statements made by the applicant in the Patent Office that those temperatures were at least 1927°C. The

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argument before the Patent Office was relied upon as furnishing evidence of what the terms of the claim meant. The Court held that rather than hold the patent invalid for want of clarity of the patent claim terms, it would determine from other evidence what the terms as used in the patent were intended to mean.

There is no question of that kind in this case.

There is no case which carries the doctrine of file wrapper estoppel to the point to which Petitioner here would push it. There is no conflict between the decision on the issue of file wrapper estoppel in this case and the other decisions to which Petitioner refers.

Petitioner's Third "Question Presented" Is Based Upon the Contention That Petitioner's Infringing Saw Chains Omitted One Element of the Patented Combination, a Contention Rebutted By Admissions in the Petition.

The third question offered by Petitioner (Pet., p. 3) reads:

> "3. Can a court hold that infringement exists solely on the basis of equivalency where the accused device completely omits one of the elements of the patentee's combination, no element being substituted for the omitted element and the remaining elements being unchanged; and where the patentee taught the public that the omitted element was essential to the invention?"

The District Court in its Findings 8-10 (R. 328, 330, 331) found that the accused saw chains did exactly the same work as those of the Hassler patent and in the same way. The Court found specifically that the illustrations of the method of operation shown in Plaintiff's Exhibits 1c-4c (R. 295-298) accurately illustrated the manner in which the infringing saw chains operated. Those illustrations are practically identical, except for slight changes in struc-

ture, with the corresponding illustration in the Hassler patent (Fig. 12, R. 348).

As has been stated, the only difference between the two types of saw chains made by Petitioner is that in the types held to infringe by the District Court there are separate vertical side cutters, while in the types also held to infringe by the Court of Appeals the work of these side cutters has been shifted to the sharpened vertical shanks of the router teeth. No function has been omitted. No change in method or principle of operation has been effected.

In Petitioner's statement of the case, Petitioner describes the functions and operation of the respective side cutter and router teeth shown in the Hassler patent (Pet., p. 4):

> "* * * In operation the side walls of the saw groove or kerf are defined by the side cutting teeth, while the kerf bottom is formed by the lateral toe portions of the L-shaped teeth. The vertical shanks of the L-shaped teeth follow in the path of the side cutting teeth, *but do no cutting themselves.* * * *" (Emphasis supplied.)

Petitioner concedes that the infringing saw chains have no "side cutting teeth" but that the sharpened vertical shanks of the L-shaped teeth make the vertical cuts which, in the preferred embodiment of Hassler, were made by the side cutting teeth. This is incontrovertible. It was held both by the District Court and the Court of Appeals (Finding 10; R. 331; Pet. App., p. 6).

Thus Petitioner concedes that it has shifted the work of the separate side cutting teeth, omitted in the infringing saw chains, to the sharpened vertical shanks of the router teeth which, in the preferred embodiment of Hassler, Petitioner says "do no cutting themselves". There is thus a plain substitution. This shift in the cutting func-

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tion from a separate side cutter to the sharpened vertical shank of the router, particularly in view of the fact that Hassler's patent showed the form of router teeth which made this substitution possible, creates the clearest kind of equivalency.

Petitioner could not make the contentions presented under this alleged question if it had not shut its eyes completely to what this Court said of the law of equivalents in *Graver* v. *Linde*, 339 U. S. 605, 607-609, quoted on page 34 of Petitioner's Appendix.

All that Petitioner contends for is that this Court shall reverse itself and make the law of equivalents "the prisoner of a formula * * * and an absolute to be considered in a vacuum."

On this question Petitioner cites *McClain* v. *Ortmayer*, 141 U. S. 419, which is also cited in both of this Court's opinions in *Graver* v. *Linde*. In that case, the patent claim covered a sweat pad for a horse collar which had springs to grasp the front wales of the collar and separate springs independently to clasp the afterwales of the collar. The accused device had only a single spring hook made of wire which clasped the front roll of the collar, with no modification at all of the structure to provide means for accomplishing the function of the after-spring. There was thus both omission of a structural element and complete omission of its function. Obviously there was neither direct infringement of the claim, which specifically called for both sets of springs, nor was there any equivalency, as the accused structure had no provision for accomplishing the function of the after-springs. The accused device therefore could not accomplish the same result in substantially the same manner by substantially the same means.

Any attempt to evoke a conflict by comparing the rul-

ing in the present case with *McClain* v. *Ortmayer* must fail. Here no function of any element has been omitted. Here the sharpened vertical shanks of the router teeth, which in the preferred embodiment did no cutting, have been burdened with the entire work of making the vertical cut in the operation of the saw, as found both by the District Court and the Court of Appeals. In *McClain* v. *Ortmayer, one entire element was omitted with complete omission of its function.* There is no conflict between these two cases.

The able statement by Judge Learned Hand in *Claude Neon Lights* v. *Machlett,* 36 F. 2d 574, as to the problems raised by the doctrine of equivalency has been fully answered by this Court's opinion in the case of *Graver* v. *Linde* where this Court sets forth the considerations that will be determinative in applying the doctrine of equivalents. That Judge Learned Hand did not adhere to his suggested position that there should be no doctrine of equivalents, is clearly disclosed by his opinion in the case of *Musher Foundation* v. *Alba Trading Co.,* 150 F. 2d 885, where he not only recognized the doctrine and applied it rather generously but actually cited his earlier opinion in the *Claude Neon Lights* case.

The cases of *Sears Roebuck & Co.* v. *Delta Mfg. Co.,* 78 F. 2d 745, and *Apex Electrical Mfg. Co.* v. *Maytag Co.,* 122 F. 2d 182, both in the Seventh Circuit, rather than creating any conflict with the ruling of the Seventh Circuit in this case or any of the other cases cited by Petitioner, actually are in direct line with the classic authorities on the doctrine of equivalents. They hold that where the accused device does not contain all of the elements of the patentee's preferred embodiment but does perform the same functions in substantially the same manner with substantially the same means, infringement will follow.

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Petitioner does not content itself with the doctrine of these cases, but seeks to engraft a further limitation upon the doctrine of equivalents to the effect that the removal of one element—even though its function and structure are incorporated in another element of the combination—prevents the application of the doctrine. This is an attempt to engraft upon a substantial doctrine an irrational, formalistic technicality which this Court has warned against in the case of *Graver* v. *Linde*, 339 U. S. 605, 608-609.

The Fourth "Question Presented" Is Raised By a Motion to Reopen Judgment Filed in the Court of Appeals, the Record of Which Has Not Been Brought to This Court, But Which in Any Event Does Not Raise This Issue.

Petitioner states as its fourth question (Pet., p. 3):

> "4. Is evidence of the inherent operation of an old device inadmissible to prove anticipation merely because the old device is disclosed in the drawings of a patent issued by a foreign country?"

This question is based upon Petitioner's Motion to Reopen Judgment, based on allegedly newly discovered evidence, which was filed in the Court of Appeals and disposed of by a separate opinion of that Court (Pet. App., pp. 15-20).

None of the voluminous documents filed by Petitioner in the Court of Appeals upon that Motion to Reopen Judgment are presented here under the certificate of the Clerk of the Court of Appeals, according to the notice served upon Respondent by Petitioner of the documents filed. Petitioner has contented itself with two sheets of figures reconstructed from three patents to Serin, one British and two French, upon which that Motion was based (Pet. App., pp. 67-68). Petitioner has not chosen to include in its

record here the text of those patents, the reconstructed links filed in the Court of Appeals by Petitioner as alleged embodiments of the disclosures of these patents, nor any of the material filed by Respondent in that Court demonstrating the complete lack of merit in the Motion to Reopen.

The Petition would make it appear that the Court of Appeals disposed of the Motion to Reopen summarily on the ground that since the patents relied upon by Petitioner in that Court were foreign patents, some new test of anticipation placing "allegedly anticipating foreign patents * * * in a radically different category from prior American patents" (Pet., p. 13) was applied by the Court of Appeals.

Were the question of the ruling by the Court of Appeals on the Motion to Reopen reviewable here except as a question of discretion (*Toledo Scale Co.* v. *Computing Scale Co.*, 261 U. S. 399, 420-421), it could be readily pointed out that the Court of Appeals even by-passed the substantial challenge to Petitioner's diligence in presenting the Motion to Reopen, in order to consider on the merits the allegedly anticipatory patents to Serin. The Court concluded that these patents presented no more than a refinement on the Shipe patent, which the Court had fully considered in its original opinion. The extensive opinion by the Court of Appeals on the Serin patents is set forth in Petititioner's Appendix, pages 15-20.

The references to *Carson* v. *American Smelting & Refining Co.*, 4 F. 2d 463, 465 by the Court of Appeals merely announced agreement with the rule of law long recognized by the United States courts as a practical restatement of the dictates of the Patent Act. That rule is that a patent is not anticipated by any publication or patent which does not exhibit the invention in such clear and exact

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terms as to enable a person skilled in the art to practice the disclosure without the necessity of making experiments. Neither in the *Carson* case nor in this case did the Court of Appeals summarily reject the foreign patent as a reference because of its foreign origin, but in both cases the Court carefully examined the disclosure to determine whether or not there was a publication adequate to teach the invention.

Further, in this case, the Court of Appeals not only satisfied itself independently of the inadequacy of the reference, but further found that the foreign reference disclosed merely a refinement of the disclosure of the Shipe patent which had been demonstrated to be structurally and functionally nonanalogous to the patent in suit.

The ruling by the Court of Appeals was thus squarely on the substance of the disclosure of the Serin patents and did not turn upon any special rule of construction.

No conflict with other decisions in other circuits exists.

The Petition should be denied.

Respectfully submitted,

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